

REMARKS

This document is a response to a non-final Office action that was mailed on May 28, 2008.

Claims 1-22 stand rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 stands rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,240,091 to Ginzboorg *et al.* ('Ginzboorg'). Claims 2-22 stand rejected as being unpatentable over Ginzboorg in view of U.S. Patent No. 5,913,040 to Rakavy *et al.* ('Rakavy').

To determine obviousness under 35 USC §103(a), "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007) quoting *Graham v. John Deere Co., of Kansas City*, 383 U.S. 1 (Sup. Ct. 1966)

A telephone interview was held on August 27, 2008 between Examiner Brian Fertig and applicant's representative Dmitry Andreev. A concurrently filed Communication to Record Substance of Interview is incorporated herein by reference.

Without conceding that claims in their prior form are not allowable over the prior art, applicant herein without prejudice of disclaimer, present, various claim amendments for purposes of expediting allowance, while maintaining the right to prosecute claims directed to previously pending claim combinations in this or another application e.g., a continuing application.

With respect to independent claim 1, the claim in its amended form is believed to be patentable over the prior art of record at least since the prior art of record fails to teach or even suggest an information terminal being adapted to allow the customer to select a desired charging method information from the transmitted charging table, wherein said charging method information includes "at least one information item selected from the group consisting of: a size of the advertisement displayed on the

information terminal, a number of advertisements displayed on the information terminal, electronic commerce deal amount, electronic commerce deal frequency, and communication traffic state information concerning a communication traffic state in the public network.”

With respect to the claim element reciting the size of the advertisement displayed on the information terminal, the applicant respectfully asserts that while Rakavy discloses an advertisement information record including an advertisement size, the prior art of record at least fails to teach or even suggest an information terminal configured to allow the customer to select a charging method based on the size of displayed advertisements.

With respect to the claim element reciting the number of advertisements displayed on the information terminal, the applicant respectfully asserts that while Rakavy discloses an advertisement information record including an advertisement size, the prior art of record at least fails to teach or even suggest an information terminal configured to allow the customer to select a charging method based on the number of displayed advertisements.

With respect to the claim element reciting electronic commerce deal amount and frequency, the applicant respectfully asserts that the prior art of record at least fails to teach or even suggest electronic commerce in any context. The applicant further respectfully asserts that even if the Examiner’s view of Ginzboorg disclosing “information about the frequency and content of all of a users [sic!] interaction with the Internet”¹ were true, Ginzboorg at least fails to teach or even suggest an information terminal configured to allow the customer to select a desired charging method based on electronic commerce deal amount and frequency.

With respect to the claim element reciting the communication traffic state information concerning a communication traffic state in the public network, the applicant

¹ Office Action of May 28, 2008, page 15

respectfully asserts that the passage of Ginzboorg relied upon by the Examiner in the outstanding office action discloses a charging server sending an OK message to the access server in response to the charging server storing an accepted contract charging record (CDR) in the charging database², and is absolutely silent as to the communication traffic state in the public network. If the Examiner wishes to assert an inherency argument in support of the finding that Ginzboorg teaches all the elements of claim 1, the Examiner is respectfully requested to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art,³ since the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.⁴

Dependent claims 3-4 and 7-10 are believed to be allowable at least for their dependence on an allowable base claim 1, and for additional combination of elements the claims recite.

With respect to independent claim 2, the claim in its amended form is believed to be patentable over the prior art of record at least since the prior art of record fails to teach or even suggest selection by the customer of a desired charging method information from the information in the charging table, wherein said charging method information includes "at least one information item selected from the group consisting of: a size of the advertisement displayed on the information terminal, a number of advertisements displayed on the information terminal, electronic commerce deal amount, electronic commerce deal frequency, and communication traffic state information concerning a communication traffic state in the public network," as discussed herein *supra*.

² U.S. Patent No. 6,240,091 Col. 9 lines 50-55

³ *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) cited in *MPEP §2112*

⁴ *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) cited in *MPEP §2112*

Dependent claims 13-14 and 17-20 are believed to be allowable at least for their dependence on an allowable base claim 2, and for additional combination of elements the claims recite.

The Examiner will note that the applicant has added new claims 23-26. Newly added claim 23 is believed to be patentable over the prior art of record at least since the prior art of record fails to teach or even suggest an information terminal configured to automatically change a provider as discussed herein *supra*.

Dependent claims 15-16 and 21-22 are believed to be allowable at least for their dependence on the base claim 23 which is believed to be allowable as discussed herein *supra*, and for additional combination of elements the claims recite.

Newly added claim 24 is believed to be patentable over the prior art of record at least since the prior art of record fails to teach or even suggest “presenting a user with a charging method information including at least one information item selected from the group consisting of: a size of the advertisement displayed on the information terminal, a number of advertisements displayed on the information terminal, electronic commerce deal amount, electronic commerce deal frequency, and communication traffic state information concerning a communication traffic state in the public network,” as discussed herein *supra*.

Newly added claim 25 is believed to be patentable over the prior art of record at least since the prior art of record fails to teach or even suggest “automatically select[ing] a provider from [an] access setting database “ as discussed herein *supra*.

With respect to newly added claim 26, the claim is believed to be patentable over the prior art of record at least since the prior art of record fails to teach or even suggest the information terminal being configured to automatically change a provider. The applicant respectfully asserts that Rakavy’s teaching of multiple advertisement servers referred to by the Examiner in the outstanding Office Action⁵ could not be analogized to

⁵ Office Action of May 28, 2008, page 11

the applicant's teaching of automatically selecting an Internet server provider (ISP), since an ISP provides network connectivity rather than content provided by an advertisement server, and thus a process and means of selecting an ISP can be materially different from a process and means allowing to select an advertisement server. Applicant's representative further respectfully asserts that while the passage of Ginzboorg referred to by the Examiner in the outstanding Office Action⁶ discloses "several different access server providers ... connected to a shared router R1,"⁷ Ginzboorg does not teach the ability of an information terminal to automatically change a provider.

Dependent claims 5-6 and 11-12 are believed to be allowable at least for their dependence on the base claim 26 which is believed to be allowable as discussed herein *supra*, and for additional combination of elements the claims recite.

The applicant's selective treatment and emphasis of independent claims of the application should not be taken as an indication that the applicant believes that the Examiner's dependent claim rejections are otherwise sufficient. Applicant expressly reserves the right to present arguments traversing the propriety of the dependent claim rejections later in the prosecution of this or another application.

While the applicant herein may have highlighted a particular claim element of a claim for purposes of demonstrating insufficiency of the examination on the part of the Examiner, the applicant's highlighting of a particular claim element for such purpose should not be taken to indicate that the applicant has asserted an argument in support of patentability that a particular claim element constitutes the sole basis for patentability out of the context of the various combinations of elements of the claim or claims in which it is present. The applicant notes that applicant maintains the right here forward to assert that each claim is patentable by reason of any patentable combination recited therein.

No amendment presented herein contains new matter.

⁶ Office Action of May 28, 2008, page 11

⁷ U.S. Pat. No. 6,240,091 Col. 6 lines 61-67 and Figs. 3c-3d

Accordingly, in view of the above amendments and remarks, the applicant believes all of the claims of the present application to be in condition for allowance and respectfully requests reconsideration and passage to allowance of the application.

If the Examiner believes that contact with the applicant's attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call the applicant's representative at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

Dated: August 28, 2008

Respectfully submitted,

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